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LG ELECTRONICS MOBILECOMM U.S.A., INC.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

ZOLTAR SATELLITE SYSTEMS, INC., a  
Delaware corporation

v.

LG ELECTRONICS MOBILE  
COMMUNICATIONS COMPANY, aka LG  
ELECTRONICS MOBILECOMM; LG  
ELECTRONICS, INC.; MOTOROLA, INC.;  
AUDIOVOX COMMUNICATIONS  
CORPORATION; UTSTARCOM INC.;  
UTSTARCOM PERSONAL  
COMMUNICATIONS, fka AUDIOVOX  
COMMUNICATIONS CORPORATION;  
SANYO NORTH AMERICA CORPORATION;  
SANYO ELECTRIC CO., LTD.; PALM, INC.,  
WHEREBY WIRELESS, INC.; SPRINT  
CORPORATION

Civil Action No. 5:06-CV-00044-JW

**MEMORANDUM OF POINTS AND  
AUTHORITIES IN SUPPORT OF  
DEFENDANT LG ELECTRONICS  
MOBILECOMM U.S.A., INC.'S MOTION  
FOR SUMMARY JUDGMENT OF  
COLLATERAL ESTOPPEL**

Date: June 11, 2007

Time: 9:00 a.m.

Judge: Honorable James Ware

Courtroom: 8

1 **I. INTRODUCTION**

2 This case is simply another attempt by Plaintiff Zoltar Satellite Alarm Systems, Inc.  
 3 (“Zoltar”) to relitigate patent infringement allegations already decided against it by a jury and this  
 4 Court, culminating in the entry of final judgment and an award of attorneys’ fees against Zoltar.  
 5 Zoltar’s claims against LG Electronics MobileComm U.S.A. Inc. (“LGE MobileComm”) are barred  
 6 by collateral estoppel to the extent they accuse the MS-assisted mode of operation of LGE  
 7 MobileComm cellular telephone handsets containing Qualcomm MSM chipsets using gpsOne  
 8 technology. To prevent Zoltar from wasting the resources of this Court and the new panoply of  
 9 defendants it has sued for using technology already deemed noninfringing by this Court, LGE  
 10 MobileComm seeks an order granting summary judgment of collateral estoppel.

11 In this suit, Zoltar accuses defendants (manufacturers and/or sellers of cellular telephone  
 12 handsets) of infringing four related patents - U.S. Patent Nos. 5,650,770 (“the ’770 patent”),  
 13 5,963,130 (“the ’130 patent”), 6,198,390 (“the ’390 patent”), and 6,518,889 (“the ’889 patent”)  
 14 (collectively, the “Zoltar Patents”). Three of these patents were at issue in the prior lawsuit filed by  
 15 Zoltar against Qualcomm, Inc., SnapTrack, Inc. and Sprint Corp. (collectively, “Qualcomm”) and  
 16 fully litigated in this Court. The fourth patent – the ’889 patent – is a closely-related continuation-  
 17 in-part of the ’390 patent that shares much of its scope and written disclosure and many of its claim  
 18 terms.

19 In that first patent infringement case, *Zoltar Satellite Alarm Systems, Inc. v. SnapTrack, Inc.,*  
 20 *Qualcomm, Inc. and Sprint Corp.*, Case No. C-01-20291 JW (“*Zoltar I*”), filed in this Court five  
 21 and a half years ago, Zoltar accused Qualcomm of infringing the ’770, ’130 and ’390 patents.  
 22 Qualcomm, Inc. is the world’s dominant supplier of processor chips that serve as the “brains” of  
 23 cellular telephone handsets, provide most of their functionality, and implement the E-911  
 24 technology accused by Zoltar of infringement (referred to by Qualcomm, Inc. as “gpsOne chipset  
 25 technology”). Specifically at issue in the previous litigation was one mode of determining handset  
 26 location implemented by Qualcomm Inc.’s gpsOne chipset referred to as “Mobile Station Assisted”  
 27 (“MS-assisted”).

1 As the Court knows, Zoltar lost on every infringement claim it brought against Qualcomm  
2 with respect to those patents, and further suffered three adverse Markman rulings, several adverse  
3 summary judgment rulings, an adverse jury verdict and adverse post-trial rulings. Most relevant  
4 here, the Court found that handsets containing the accused Qualcomm chipsets did not infringe due  
5 to the absence of (1) the “location” claim limitation; (2) the “demodulator” claim limitation; and (3)  
6 the “precise time-of-day” claim limitation” as applied to the MS-assisted mode of operation of  
7 gpsOne chipset technology. With nothing left in the case but Qualcomm’s invalidity counterclaim,  
8 Zoltar agreed to final judgment entered against it on December 5, 2006.

9 Having lost, Zoltar ran from this Court to try again in Texas, this time against Qualcomm’s  
10 customers who manufacture and/or sell cellular telephone handsets using Qualcomm’s gpsOne  
11 chipsets, including LGE MobileComm. Every single one of the 79 accused LGE MobileComm  
12 cellular handsets contains either the exact same Qualcomm chipsets accused of infringement in  
13 *Zoltar I* or a subsequent generation chipset using the same gpsOne chipset technology. In light of  
14 the clear overlap between the California and Texas cases, the Eastern District of Texas transferred  
15 Zoltar back to this Court.

16 What has happened since only confirms the futility of proceeding any further with respect to  
17 most of Zoltar’s infringement assertions. For example, Zoltar’s preliminary infringement  
18 contentions show that many of its infringement claims here are identical to those already decided  
19 against it by this Court and the jury. Thus, Zoltar’s contentions accusing LGE MobileComm<sup>1</sup>  
20 cellular handsets cannot stand with respect to the Zoltar Patents’ (1) “location” claim limitation  
21 (found in 12 of the 18 asserted claims); (2) “demodulator” claim limitation (found in the remaining  
22 six asserted claims); and (3) “precise time of day” claim limitation (found in the same six claims) as  
23 applied to the MS-assisted mode of operation of gpsOne chipset technology.

24 Summary judgment disposing of Zoltar’s claims against LGE MobileComm is mandated  
25 under the circumstances, and such a ruling will significantly and appropriately narrow the scope of  
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27 <sup>1</sup> With respect to Zoltar’s assertions against the other defendants in this action, collateral estoppel precludes further  
28 litigation for the same reasons stated herein, and other defendants thus are filing concurrent motions of joinder.

1 this litigation. Dozens of the handsets accused here, for example, operate only in the MS-assisted  
 2 mode of operation that was squarely at issue and found noninfringing in *Zoltar I*. See, e.g., *Amgen,*  
 3 *Inc. v. Genetics Institute, Inc.*, 98 F.3d 1328 (Fed. Cir. 1996) (affirming summary judgment  
 4 precluding patentee from asserting claims of “child” patent in second case based on determination  
 5 of issues in first case involving “parent” patent); *Molinaro v. Fannon/Courier Corp.*, 745 F.2d 651  
 6 (Fed. Cir. 1984) (affirming summary judgment barring infringement allegations in a second case  
 7 based on ruling of non-infringement in earlier case as to different products of different defendants);  
 8 *Home Diagnostics Inc. v. LifeScan, Inc.*, 120 F. Supp. 2d 864, 868 (N.D. Cal. 2000) (granting  
 9 summary judgment of collateral estoppel as to different products in a second case, noting that “[i]f a  
 10 structure in a product is found to be identical to a structure in an otherwise different, previously  
 11 litigated product, the judgment as to whether that structure meets the relevant claim element must  
 12 apply to the later litigation to avoid repetitive litigation of the same issues.”)

## 13 **II. STATEMENT OF MATERIAL FACTS**

### 14 **A. The Zoltar Patents**

15 Zoltar alleges that wireless emergency location determination technology deployed in  
 16 wireless networks, commonly referred to as “E-911,” infringes four patents issued to Dr. Dan  
 17 Schlager and assigned to Zoltar: the ’770 patent, the ’130 patent, the ’390 patent and the ’889  
 18 patent. (Exs.<sup>2</sup> 1-4.) Three of these four patents were at issue in *Zoltar I*. The ’889 patent, issued  
 19 after *Zoltar I* was filed, is in the same patent family as the ’770, ’130 and ’390 patents and is a  
 20 continuation-in-part of the ’390 patent. (Ex. 4.) The ’889 patent also recites a voice-activated  
 21 personal alarm system, but is otherwise the same in all material respects as the other patents in its  
 22 family for purposes of this Motion. (Ex. 4. at Abstr.)

23 The Zoltar Patents claim two embodiments of personal alarm systems with position location  
 24 technology: (1) those that receive navigational information and calculate a location in the remote  
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26 <sup>2</sup> Unless otherwise noted, all exhibits referenced herein are appended to the Declaration of Shelley K. Mack in  
 27 Support of LGE MobileComm’s Motion for Summary Judgment of Collateral Estoppel (“Mack Decl.”), submitted  
 28 herewith.

unit, or handset (“the handset claims”), and (2) those that receive and demodulate navigational information and generate a precise time-of-day in the remote unit, and transmit the demodulated navigational and precise time-of-day information to a base station, or cellular tower system, where a location is calculated (“the base station claims”). (Ex. 5 at 2:6-8.)

Claim 55 of the ’770 patent, from which asserted claim 61 depends, is exemplary of the handset claims:<sup>3</sup>

55. A personal alarm system remote unit comprising:

a navigational receiver for providing a **location**<sup>4</sup> of the remote unit;

at least one manually operated switch having an output, the at least one switch defining a panic button; and

a radio transmitter connected for receiving the remote unit location, the at least one switch output, defining a switch status, and transmitting the remote unit location and the switch status.

The “location” requirement highlighted above was dispositive in *Zoltar I* because it was missing from the accused Qualcomm MS-assisted gpsOne chipset technology.

Claim 11 of the ’390 patent is exemplary of the base station claims:<sup>5</sup>

11. A personal alarm system remote unit, comprising:

a navigational receiver for receiving navigational information;

a **demodulator** for demodulating the received navigational information;

timing circuits for providing **precise time-of-day information**;

a manually operated switch defining a panic button and having an output signal defining a switch status wherein operation of the panic button produces a change in the switch status; and

radio transmitter for transmitting the demodulated navigational information, the precise time-of-day information, and the switch status.

<sup>3</sup> The handset claims include 12 of the 18 asserted claims--claim 61 of the ’770 patent, claims 28-29, 31-32 and 34-35 of the ’130 patent, and claims 1, 8-9, and 12-13 of the ’889 patent.

<sup>4</sup> Unless otherwise noted, all emphasis throughout this brief has been added.

<sup>5</sup> The base station claims include the remaining six of the 18 asserted claims--claim 11 of the ’390 patent and claims 14, 17-18 and 21-22 of the ’889 patent.

1 The “demodulator” and “precise time-of-day information” requirements highlighted above were  
 2 also dispositive in *Zoltar I*, as both were found absent from the accused MS-assisted mode of  
 3 operation of Qualcomm gpsOne chipset technology.

4 The claims of all four Zoltar Patents are directed to the same subject matter and use the same  
 5 terms and phrases. Claim 14 of the ’889 patent, for instance, differs from claim 11 of the ’390  
 6 patent only in that the alarm described in claim 14 uses a “voice activated detector” while the alarm  
 7 of claim 11 is activated by a “manually operated switch.” (*Compare* Ex. 4 at 31:15-28 with Ex. 3 at  
 8 29:38-52.) Viewed in light of the terms construed in *Zoltar I*, the similarities between the ’889  
 9 patent and the three patents at issue in *Zoltar I* are even more striking. The terms construed in  
 10 *Zoltar I* appear repeatedly throughout the claims of the ’889 patent; claim 4, for instance, includes  
 11 at least fifteen terms already construed in *Zoltar I*. (Ex. 4 at 29:64-30:24.)

12 Most critically, the key terms at issue in this Motion and interpreted in *Zoltar I* – (1) a  
 13 “navigational receiver for providing a **location** of the remote unit,” (2) “timing circuits for  
 14 providing **precise time-of-day information**,” and (3) a “**demodulator** for demodulating received  
 15 navigational information” – all appear in the presently asserted claims of the ’889 patent. (*Id.* at  
 16 29:41-43, 30:50-54, 31:15-21, 32:4-10.) Forty-three of the ’889 patent’s fifty-one figures appear in  
 17 the ’390 patent, as does most of its specification. Since the ’889 patent is in the same priority chain  
 18 as the other Zoltar Patents, limitations on the scope of those patents apply equally to the ’889 patent.  
 19 *See* Section IV(A)(4)(a), *infra*.

## 20 **B. The *Zoltar I* Complaint**

21 On March 30, 2001, Zoltar sued Qualcomm in this Court in *Zoltar I*, alleging that  
 22 Qualcomm’s gpsOne wireless location determination technology infringed claims 32, 34, 36-37 and  
 23 55 of the ’770 patent, claims 13-14, 28-32 and 34-35 of the ’130 patent, and claim 11 of the ’390  
 24 patent.<sup>6</sup> (Ex. 6, ¶¶ 11, 18.) Zoltar asserted that Qualcomm directly infringed, contributorily  
 25 infringed, and induced infringement of the Zoltar Patents by making, using, offering for sale and/or

26  
 27 <sup>6</sup> Claims 32 and 55 of the ’770 patent, claims 13-14 and 28 of the ’130 patent, and claim 11 of the ’130 patent are  
 28 independent; claims 34 and 36-37 of the ’770 patent and claims 29-32 and 34-35 of the ’130 patent are dependent.

1 selling “hardware and/or software products involving wireless device location technology such as  
2 the E-911 service, including the MSM3300 chip sets.” (*Id.* at ¶ 11.)

3 During pre-trial proceedings in *Zoltar I*, Zoltar abandoned its infringement allegations as to  
4 claims 34, 36-37 and 55 of the ’770 patent and claims 14, 28-29 and 34-35 of the ’130 patent, and  
5 final judgment in *Zoltar I* was rendered establishing no infringement of claim 32 of the ’770 patent,  
6 claims 31-32 and 34-35 of the ’130 patent, and claim 11 of the ’390 patent.

### 7 **C. The Accused Products in *Zoltar I***

8 The Qualcomm MSM 3300 and MSM 5100 chipsets at issue in *Zoltar I* embodied  
9 Qualcomm’s Assisted GPS (“A-GPS”) technology. (Ex. 12 at 1599:10-14.) A-GPS differs from  
10 stand-alone GPS in that it relies on assistance from other ground-based elements of a wireless  
11 network to facilitate location determination. (Ex. 9 at 1.) A-GPS is a cellular location solution that,  
12 unlike stand-alone GPS, works in challenging environments. (*Id.* at 1-2.) Qualcomm developed its  
13 A-GPS position location technology, called “gpsOne,” in response to the “enhanced” or “E”-911  
14 mandate from the Federal Communications Commission (“FCC”) requiring wireless telephone  
15 carriers to upgrade their systems so that when a cellular phone user makes a 911 call, the user’s  
16 location is pinpointed within 30 seconds of call placement. (Ex. 10 at 1-2.) The MSM 3300 and  
17 5100 chipsets accused in *Zoltar I* use gpsOne technology, which assists wireless carriers to comply  
18 with the FCC’s E911 mandate. (Ex. 11 at ¶ 11.)

19 Qualcomm’s gpsOne chipsets function in three modes of operation: “stand-alone GPS,”  
20 “Mobile Station (“MS”)-based” and “MS-assisted.”<sup>7</sup> (Ex. 9 at 1.) In MS-assisted mode, “gpsOne  
21 technology utilizes assistance data from a location server in the wireless network in combination  
22 with A-GPS circuitry and software in the wireless device.” (*Id.* at 3.) The “GPS receiver uses  
23 assistance data from a location server to make measurements related to its distance from the GPS  
24 satellites, then sends this information to the location server where the position is calculated.” (*Id.*)

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28 <sup>7</sup> The “MS-assisted/Hybrid” operational mode is a subcategory of the “MS-assisted” mode. (Patrick Decl., n. 1.)



1 The accused MSM 3300 and 5100 chipsets in *Zoltar I* operated in MS-assisted mode.<sup>8</sup> (Ex. 12 at  
2 1599:10-14.)

3 **D. The Adverse Rulings and Verdict in *Zoltar I***

4 **1. This Court's Three *Markman* Rulings in *Zoltar I***

5 Two separate claim construction hearings were held, three lengthy rounds of briefing were  
6 conducted, and three extensive *Markman* rulings were issued by this Court in *Zoltar I*. The Court  
7 even permitted the parties to file overlength claim construction briefs to ensure their positions were  
8 fully evaluated on the merits. (Ex. 18.) After the first *Markman* hearing on March 29, 2002, the  
9 Court issued its first claim construction ruling on May 16, 2002, construing thirteen claim terms.  
10 (Ex. 19 at 3-7.) Following a second *Markman* hearing on January 23, 2003, the Court issued a  
11 second *Markman* order on February 27, 2003 construing four additional terms. (Ex. 20.) Finally,  
12 this Court permitted additional briefing on the term "location" and issued a third *Markman* ruling  
13 refining its construction of that term on November 17, 2003. (Ex. 21.)

14 In its first *Markman* order, after thorough analysis of the intrinsic evidence, the Court  
15 construed the means-plus-function element "demodulator for demodulating the received  
16 navigational information" to have the structure of "a circuit within the navigational receiver which  
17 extracts positional aiding information from an electronic signal or carrier." (Ex. 19 at 5.) The  
18 Court construed means-plus-function element "timing circuits for providing precise time-of-day  
19 information" to have the function of "provid[ing] precise time of day information" and the structure  
20 of "circuitry for generating and/or storing precise time of day information, as represented by Fig. 19  
21 (610) of the 770 patent." (*Id.*)

22 In its second *Markman* order, after the same careful analysis, the Court construed the term  
23 "location" in the phrase "navigational receiver for providing a location of the remote unit" to mean  
24 "a position or site occupied or available for occupancy or marked by some distinguishing feature,"  
25 including "distance from a central point." (Ex. 20 at 3.) The Court construed the term "providing  
26 precise time-of-day information" in the phrase "timing circuits for providing precise time-of-day  
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28 <sup>8</sup> Neither the "stand-alone GPS" nor the "MS-based" modes of operation are the subject of the present motion.



1 information” to mean “providing a measure of time sufficiently precise to substitute for one satellite  
2 measurement,” noting that Plaintiff’s own expert endorsed this construction. (*Id.* at 4.)

3 In its third *Markman* ruling, the Court refined its construction of the term “location” as  
4 follows: “[t]he term ‘location’ means a position or site occupied or available for occupancy or  
5 marked by some distinguishing feature. The term ‘location’ is broad enough to include the concept  
6 of a distance from a fixed, central point on the earth.” (Ex. 21 at 1.)

## 7 **2. The Court’s Summary Judgment Rulings in *Zoltar I***

8 The parties filed more than ten summary judgment motions on a variety of infringement and  
9 validity issues in *Zoltar I*. The Court issued orders that, among other things, (1) granted summary  
10 adjudication of no literal infringement of claims 31-32 and 34-35 of the ’130 patent (Ex. 22) and  
11 denied summary judgment of infringement of claims 31 and 32 of the ’130 patent and claim 11 of  
12 the ’390 patent (Ex. 23). In granting summary adjudication of no literal infringement, the Court  
13 ruled that the “pseudorange” provided by the handset is not a “location” as defined by the Court,  
14 and that a pseudorange is only one piece of information needed to determine location. (Ex. 22 at 3.)  
15 See Section IV(A)(1), *infra*. Denying summary judgment of infringement, this Court found that  
16 Zoltar had not shown that the accused handsets calculate and transmit “location,” or that they  
17 provide “precise time-of-day information.” (Ex. 23 at 4-5.) Zoltar was denied leave to seek  
18 reconsideration of the Court’s Order on September 29, 2003. (Ex. 24.)

## 19 **3. The *Zoltar I* Jury Trial and JMOL Ruling**

20 After three years of preparation, three Markman hearings, and ten summary judgment  
21 motions, *Zoltar I* was tried to a jury in February and March 2004. The jury “heard evidence that  
22 various companies which manufacture cellular telephone handsets have purchased from Qualcomm  
23 MSM 3300 and 5100 chipsets,” “evidence that these chipsets are incorporated into certain cellular  
24 telephone handsets,” and “evidence about SnapTrack’s products and services and how those  
25 products and services may be used in a cellular telephone network by Sprint and Verizon Wireless.”  
26 (Ex. 14 at 2218:6-15.) At the close of evidence, the parties filed motions for judgment as a matter  
27 of law; the motions were taken under submission, and the case submitted to the jury. (Ex. 25 at  
28

1 1:19-21.) On March 25, 2004, after a three-week trial and lengthy deliberations, the jury rendered a  
2 partial verdict finding no direct, contributory infringement or induced infringement, either literally  
3 or under the doctrine of equivalents, of claim 32 of the '770 patent, and claims 13, 31, 32, 34 and 35  
4 of the '130 patent. (Ex. 26 at 2-3, 7-11; Ex. 27 at 2427:17-2428:1; 2428:8-10, 12-13, 15-16, 18-19,  
5 21-22; 2430:3-2431:5.) The jury was unable to reach a verdict as to infringement of claim 11 of the  
6 '390 patent. (Ex. 27 at 2431:22-2432:7.)

7 After the verdict was returned, the parties renewed their motions for judgment as a matter of  
8 law, and Zoltar moved in the alternative for a new trial on claim 11 of the '390 patent. (Ex. 25 at  
9 1.) Those motions were briefed and argued, and on June 26, 2004, the Court entered judgment in  
10 favor of Qualcomm and against Zoltar as to infringement of the '770 and '130 patents, granted  
11 Qualcomm's motion for judgment as a matter of law of noninfringement of claim 11 of the '390  
12 patent, and denied Zoltar's motion for a new trial. (*Id.* at 5.) As to claim 11, the Court ruled that  
13 Zoltar presented no evidence that the accused products had a demodulator or timing circuits for  
14 providing precise time-of-day information, as required by the claims. (*Id.* at 4.)

#### 15 4. This Court's Entry of Judgment and the Federal Circuit Appeal

16 On July 26, 2004, a judgment consistent with the Court's Order of the same day was  
17 entered. (Ex. 28.) Zoltar appealed to the Federal Circuit, which dismissed the appeal on February  
18 1, 2005 for lack of a final judgment based on unadjudicated counterclaims. (Ex. 29 at 2.) On  
19 February 24, 2005, Zoltar moved for certification of judgment, a collateral order or dismissal of  
20 Qualcomm's counterclaims without prejudice. After argument, the Court denied Zoltar's motion  
21 but "modif[ied] its Interlocutory Judgment to declare that the accused products do not infringe the  
22 asserted claims of the patents in suit" and ordered further proceedings as to unenforceability of the  
23 '770 patent and invalidity of the '130 patent. (*Id.* at 3-8.) With nothing left in the case but the  
24 validity challenge to its patents, Zoltar agreed to the entry of final judgment against it, which was  
25 duly entered on December 5, 2006 along with an award of attorneys' fees to Qualcomm. (Ex. 30.)  
26  
27  
28

**E. The *Zoltar II* Complaint and Accused Products**

On June 7, 2005, Zoltar filed this patent infringement suit in the Eastern District of Texas against eleven defendants, alleging infringement of the '770, '130, '390 and '889 patents. (Ex. 7.) Zoltar alleged that defendants infringed the Zoltar Patents by "inducing and contributing to the manufacture, use, sale, and/or offer for sale of cellular telephones equipped with E-911 technology." (*Id.* at 3.) The case was transferred to this Court on January 6, 2006. Zoltar filed its First Amended Complaint on January 19, 2007, dropping one defendant and adding four. (Ex. 8.)

In this case, Zoltar alleges that defendants' cellular handsets using Qualcomm's MSM chipsets and the cellular wireless systems with which those handsets are used infringe the Zoltar Patents. Zoltar asserts that 79 LGE MobileComm handsets infringe the Zoltar patents; of those handsets, 54 operate only in MS-assisted mode, 24 operate in one or more other modes, and one has no GPS receiver at all.<sup>9</sup> (Declaration of Kyung-keun Choi in Support of Motion for Summary Judgment of Collateral Estoppel ("Choi Decl."), ¶ 4.) The Qualcomm MSM chipsets contained in the *Zoltar II* accused products are either the very same chipsets at issue in *Zoltar I* or next generation chipsets building on the original MSM 3300/5100 chipset technology. (Declaration of Chris Patrick in Support of Motion for Summary Judgment of Collateral Estoppel ("Patrick Decl."), ¶¶ 3-4.) All Qualcomm chipsets, and all LGE MobileComm handsets in which they are included, employ the gpsOne chipset technology at issue in *Zoltar I*. (*Id.*, ¶¶ 4-7; Choi Decl., ¶¶ 5-9.)

**F. Zoltar's Infringement Contentions in *Zoltar I* and *II***

There is no dispute that plaintiff's infringement contentions in *Zoltar I* are the same as those it advances here. While the names of the accused cellular handsets and the chipsets they contain have changed in part, the features of those handsets that allegedly correspond to the elements of the claims are identical. In some instances, Zoltar accuses in this suit handsets containing the same MSM 5100 chipset at issue in *Zoltar I*. (Choi Decl., ¶ 4; Mack Decl., Ex. 15 at 2-3.)

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<sup>9</sup> Neither of the other modes of operation — "stand-alone GPS" or "MS-based" — are the subject of the present motion.

1                   **1.       Zoltar Makes the Same gpsOne Infringement Contentions Against All**  
 2                   **Defendants**

3           Because the Zoltar Patents are directed to personal alarm systems, Zoltar has struggled since  
 4 the beginning of the prior litigation in 2001 to read its patent claims onto A-GPS E911 technology  
 5 used by cellular phone handset manufacturers and network service providers. In its Preliminary  
 6 Infringement Contentions in this case, Zoltar alleges that all defendants use gpsOne technology  
 7 infringing the same eighteen claims, many of which were at issue in *Zoltar I*: claim 61 (dependent  
 8 from claim 55) of the '770 patent, claims 28-29, 31-32 and 34-35 of the '130 patent, claim 11 of the  
 9 '390 patent, and claims 1, 8-9, 12-14, 17-18 and 21-22 of the '889 patent. (Ex. 16.) Tellingly,  
 10 Zoltar uses the same claim charts against all defendants in this case to describe its infringement  
 11 contentions, reflecting the fact that the conventional technology it accuses is based on an industry  
 12 standard not patented by Zoltar. (*Id.*)

13                   **2.       Zoltar's Infringement Contentions in Zoltar II Are the Same**  
 14                   **Unsuccessful Contentions It Made in Zoltar I**

15           Zoltar's Final Infringement Contentions in *Zoltar I* identify Qualcomm's MSM 3300 and  
 16 MSM 5100 chipsets and "any subsequently manufactured chipsets which include a position location  
 17 processor based on gpsOne technology" as infringing products. (Ex. 17 at 1.) Zoltar's Preliminary  
 18 Infringement Contentions in this case and its Final Infringement Contentions in *Zoltar I* are  
 19 substantially the same, and identical in their reliance on rejected infringement arguments to prove  
 20 key claim limitations. Three specific infringement contentions are relevant to this Motion.

21                   **a.       Zoltar's Specific Contention in Zoltar II That the Accused**  
 22                   **Products Contain a Navigational Receiver for Providing Location**  
 23                   **Is the Same As in Zoltar I**

24           In its March 28, 2003 Second Amended Final Infringement Contentions in *Zoltar I*, plaintiff  
 25 alleged that the means-plus-function element "navigational receiver for providing a location of the  
 26 remote unit" in claims 30-32 and 34-35 of the '130 patent was met because the accused "*gpsOne*  
 27 *enabled cell phones provide a location of the remote unit* consistent with the Court's definition of  
 28 location." (*Id.* at 10.) Zoltar's infringement contention in this case as to the same element of claim  
 61 of the '770 patent, claims 28-29, 31-32 and 34-35 of the '130 patent and claims 1, 8-9, and 12-13

1 of the '889 patent is substantially identical: "[t]he [] Accused *Mobile Telephones each has [sic] a*  
 2 *GPS receiver that provides a location* of the [] Accused Mobile Telephone." (Ex. 15 at 3-4.) Both  
 3 the jury and this Court rejected this contention in *Zoltar I*.

4 **b. Zoltar's Specific Contention in *Zoltar II* That the Accused**  
 5 **Products Contain Timing Circuits for Providing Precise Time of-**  
 6 **Day Is the Same As in *Zoltar I***

7 In its Final Infringement Contentions in *Zoltar I*, Zoltar alleged the means-plus-function  
 8 limitation "timing circuits for providing precise time of day" in claim 32 of the '770 patent, claim  
 9 13 of the '130 patent and claim 11 of the '390 patent was satisfied because "*gpsOne enabled cell*  
 10 *phones include circuitry which provides precise time of day information*, consistent with or  
 11 equivalent to Fig. 19 (610) of the 770 patent. This includes, but is not limited to, one or more of the  
 12 clocks or time buffers in the MSM chip set as well as its equivalents." (Ex. 17 at 6.) Zoltar's  
 13 infringement contention here as to the same limitation of claim 11 of the '390 patent and claims 14  
 14 and 17-22 of the '889 patent is again substantially identical: "the [] Accused *Mobile Telephones*  
 15 *each has [sic] a circuit that provides precise time-of-day information* for use in determining  
 16 location." (Ex. 15 at 7.) Once again, the Court and the jury rejected this contention in *Zoltar I*.

17 **c. Zoltar's Specific Contention in *Zoltar II* That the Accused**  
 18 **Products Contain a Demodulator for Demodulating Received**  
 19 **Navigational Information Is the Same As in *Zoltar I***

20 In its *Zoltar I* Final Infringement Contentions, Zoltar alleged that the means-plus-function  
 21 limitation "demodulator for demodulating the received navigational information" in claim 32 of the  
 22 '770 patent, claim 13 of the '130 patent and claim 11 of the '390 patent was met because "[t]he  
 23 *gpsOne enabled phones include circuitry which extracts positional aiding information from an*  
 24 *electronic signal* or carrier. This includes the demodulator and/or correlator within the MSM chip  
 25 set and its equivalents." (Ex. 17 at 6.) Zoltar's infringement contention in this case as to the same  
 26 limitation of claim 11 of the '390 patent and claims 14 and 17-22 of the '889 patent remains  
 27 substantially identical: "[e]ach of the [] Accused *Mobile Telephones* receives an electronic signal  
 28 and *includes a circuit that extracts positional aiding information from the signal*." (Ex. 15 at 11.)  
 The Court and the jury also rejected this specific infringement contention in *Zoltar I*.

### III. LEGAL STANDARDS GOVERNING SUMMARY JUDGMENT OF COLLATERAL ESTOPPEL

Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *See* FED. R. CIV. P. 56(C); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). “[C]ourt[s] should utilize the salutary procedure of FED. R. CIV. P. 56 to avoid unnecessary expense to the parties and wasteful utilization of the jury process and judicial resources.” *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 835 (Fed. Cir. 1984).

The doctrine of collateral estoppel is designed, “once a court has decided an issue of fact or law necessary to its judgment,” to “preclude relitigation of the issue in a suit on a different cause of action involving a party to the first case.” *Allen v. McCurry*, 449 U.S. 90, 94 (1980). Collateral estoppel serves to “relieve parties of the cost and vexation of multiple lawsuits, conserve judicial resources, and, by preventing inconsistent decisions, encourage reliance on adjudication.” *Id.* “[T]he law is well settled that the pendency of an appeal has no effect on the finality or binding effect of a trial court’s holding.” *Pharmacia & Upjohn Co. v. Mylan Pharma., Inc.*, 170 F.3d 1373, 1381 (Fed. Cir. 1999) (citation omitted).

Under Ninth Circuit law, the defense of collateral estoppel requires proof of four elements by a preponderance of the evidence. First, the disputed issues must be identical to those in the previous litigation. *See McQuillion v. Schwarzenegger*, 369 F.3d 1091, 1096 (9th Cir. 2004). Second, the disputed issues must have been actually litigated in the prior action. *See id.* Third, the resolution of those disputed issues must have been necessary to support a final judgment in the prior case. *See id.* For purposes of collateral estoppel, a “final judgment includes any prior adjudication of an issue in another action that is determined to be sufficiently firm to be accorded conclusive effect,” and need not be a final judgment for purposes of appeal. *See, e.g., Dana v. E.S. Originals, Inc.*, 342 F.3d 1320, 1323 (Fed. Cir. 2003) (quoting Restatement (Second) of Judgments § 13 (1982)). Finally, plaintiff must have had a “full and fair” opportunity to litigate the same issue in the prior lawsuit. *See Blonder-Tongue Lab., Inc. v. University of Ill. Found.*, 402 U.S. 313, 333 (1971). Collateral estoppel bars relitigation of infringement issues decided on summary judgment

1 or at trial in a prior lawsuit. *See, e.g., Colida v. Qualcomm Inc.*, 128 Fed. Appx. 765, 766 (Fed. Cir.  
 2 2005); *Dana*, 342 F.3d at 1324; *Security People, Inc. v. Medeco Security Locks, Inc.*, 59 F. Supp. 2d  
 3 1040, 1044 (N.D. Cal. 1999).

4 **IV. ZOLTAR IS BARRED FROM RELITIGATING INFRINGEMENT ASSERTIONS**  
 5 **AGAINST THE MS-ASSISTED MODE OF OPERATION OF CELLULAR PHONE**  
 6 **HANDSETS USING GPSONE CHIPSET TECHNOLOGY WITH RESPECT TO**  
 7 **ALL ASSERTED CLAIMS**

8 Zoltar's infringement claims under all four Zoltar Patents are barred by collateral estoppel  
 9 because this Court determined in *Zoltar I* that the MS-assisted mode of operation of cellular  
 10 telephone handsets using gpsOne chipset technology does not meet at least one limitation of each  
 11 claim asserted in *Zoltar II*. All four elements required to establish collateral estoppel are easily  
 12 demonstrated here. The MS-assisted mode of operation of accused LGE MobileComm cellular  
 13 telephone handsets using gpsOne chipset technology does not meet the "location," "precise time-of-  
 14 day," and "demodulator" limitations of the Zoltar Patents. These issues have been fully, fairly and  
 15 finally adjudicated against plaintiff, and Zoltar cannot relitigate them now.

16 **A. The Issues Related to the "Location," "Precise Time-of-Day," and**  
 17 **"Demodulator" Limitations Are the Same as in *Zoltar I***

18 Each asserted claim in *Zoltar II* contains one or more of the "location," "precise time-of-  
 19 day" and "demodulator" limitations that proved dispositive in *Zoltar I*. As to each limitation, the  
 20 infringement issues involved are identical to those decided against Plaintiff in *Zoltar I*.

21 **1. Issues Regarding the "Location" Limitation Are Identical**

22 There is no genuine dispute that the issue of whether "location" is determined by cellular  
 23 telephone handsets using MS-assisted gpsOne chipset technology is identical in both suits. This  
 24 Court found in *Zoltar I* that the MS-assisted mode of operation of gpsOne chipset technology does  
 25 not provide a user's location; instead, location, as defined by the Court, is determined by the base  
 26 station. (Ex. 22 at 3.)

27 In *Zoltar I*, a claim construction hearing was held to construe "location," and two separate  
 28 *Markman* orders issued interpreting the term. This Court ruled that "location" in the phrase "a  
 navigational receiver for providing a location of the remote unit" means "a position or site occupied



1 or available for occupancy or marked by some distinguishing feature. The term ‘location’ is broad  
 2 enough to include the concept of a distance from a fixed, central point on the earth.” (Ex. 21 at 1.)  
 3 The Court later determined that the accused MS-assisted<sup>10</sup> gpsOne chipsets do not determine a  
 4 “location” as required by the Zoltar Patents, but instead calculate only a pseudorange, or a distance  
 5 from a moving satellite to the handset plus unknown error. (Ex. 23 at 4-5.) Rejecting the argument  
 6 that a pseudorange is itself or equivalent to a “location,” this Court denied Zoltar’s motion for  
 7 summary judgment of infringement of the ’130 patent and noted that:

8 Qualcomm contends its ‘navigational receiver,’ the handset, does not provide a  
 9 location, but instead provides a ‘pseudorange.’ Qualcomm explains that the  
 10 ‘pseudorange’ is not ‘a location,’ nor even information from which, by itself, a  
 11 location can be determined. Rather, Qualcomm contends that a ‘pseudorange’  
 is only one piece of information needed to calculate ‘a position,’ and that a final  
 position calculation occurs in the base station. Qualcomm’s expert, Stephen  
 Wicker, states as follows:

12 43. It should be noted that these pseudoranges are not sufficient for  
 13 determining the location of the user --- they simply indicate the approximate  
 14 distance of the user from several SV’s [space vehicle]. We also need to know  
 15 the exact locations of the SV’s in order to determine our location. Standard  
 16 ‘stand alone’ GPS receivers obtain the SV’s locations by demodulating the L1  
 signals and extracting the ephemeris data. As we will see, the accused products  
 do not do this, but instead depend on other elements of the system in which  
 they are used to demodulate the L1 signals, extract the ephemeris information  
 and perform the location computation.

17 (*Id.* at 4 (citation omitted).) The Court relied on the same opinions of Qualcomm’s expert in  
 18 granting its motion for summary adjudication of no infringement of claims 31-32 and 34-35 of the  
 19 ’130 patent, ruling that the MS-assisted mode of operation of the accused gpsOne handsets does not  
 20 determine a “location” as required by the claims:

21 Qualcomm’s ‘navigational receiver’ is the handset. Qualcomm has produced  
 22 evidence that its handset provides a ‘pseudorange.’ The Court finds that a  
 23 ‘pseudorange’ is neither a ‘position or site occupied or available for occupancy  
 24 or marked by some distinguishing feature,’ nor ‘a distance from a fixed, central  
 point on the earth.’ Instead, the undisputed evidence establishes that a  
 ‘pseudorange’ is only one piece of information needed to calculate location, and  
 that a location calculation occurs in the base station. (Ex. 22 at 3.)

25 It is precisely this issue – whether the MS-assisted mode of operation of cellular handsets  
 26 using gpsOne chipset technology determines “location” – which Zoltar seeks to relitigate in this

27 <sup>10</sup> As noted previously, all chipsets at issue in *Zoltar I* operated in MS-assisted mode. (Ex. 12 at 1599:10-14.)  
 28

case. For purposes of claim 61 of the '770 patent, claims 28-29, 31-32 and 34-35 of the '130 patent and claims 1, 8-9, 12-13 of the '889 patent, Zoltar forwards the same infringement contentions in this case as to the "location" limitation that it made in *Zoltar I*. (*Compare* Ex. 17 with Ex. 15 at 3-4.) Other jurisdictions have found the contents of a plaintiff's infringement contentions dispositive of whether the issues are identical. *See Charles E. Hill & Assoc., Inc. v. Amazon.com*, 2005 WL 2488715, at \*3 (E.D. Tex. Oct. 7, 2005). The MS-assisted mode of operation of the gpsOne chipset technology at issue in the two cases is the same for purposes of the "location" limitation of the asserted claims, even though the chipset numbers have changed. (Patrick Decl., ¶ 5.) The same claim element is at issue and asserted against products using the same gpsOne technology, leaving no doubt that there is no genuine issue of material fact as to whether issues raised regarding the term "location" are identical in *Zoltar I* and *Zoltar II*.

## 2. Issues Concerning the "Precise Time-of-Day" Limitation Are Identical

Likewise, there is no question that the issue of whether the MS-assisted mode of operation of cellular telephone handsets using gpsOne chipset technology provides "precise time-of-day" is identical in both suits. In *Zoltar I*, the Court construed "precise time-of-day information" in the phrase "timing circuits for providing precise time-of-day information" to mean "providing a measure of time sufficiently precise to substitute for one satellite measurement." (Ex. 20 at 4.) Zoltar alleged that gpsOne chipsets contain oscillators providing "precise time-of-day." (Ex. 31 at 9:16-21.) The Court rejected this argument in denying Zoltar's motion for summary judgment of infringement and granting Qualcomm's motion for judgment as a matter of law, ruling that such oscillators are not "independent, free-running timing circuit[s]" and do not provide precise time-of-day. (Ex. 23 at 5-6; Ex. 25 at 4.) Finding no evidence of infringement of claim 11 of the '390 patent, this Court ruled on Zoltar's motion for summary judgment that:

[T]here exists a genuine issue of material fact with respect to whether Qualcomm's clock in the handset provides precise time-of-day information. Qualcomm's expert Stephen Wicker, provides a lengthy explanation as follows.

63. Neither the CDMA [Code Division Multiple Access] handsets nor the accused MSM chipsets perform a function or contain a structure that corresponds to timing circuits for providing precise time-of-day information. The only timing circuit disclosed in the specification that corresponds to this

1 element is an independent, free-running timing circuit identified, for example,  
 2 as 610 in Figure 20. . . . Handsets that include the accused MSM chips, by  
 3 contrast, maintain oscillators that are continuously updated through phase  
 locking to the base station pilot signal. The base station pilot signal in the  
 CDMA system is ultimately synchronized to GPS time. . . .

4 64. The oscillators in the CDMA handset also do not perform the identical  
 5 function as the timing circuits disclosed in the patents. The CDMA handsets do  
 6 not send any explicit time information to the base station, much less provide  
 7 ‘precise time-of-day information.’ They instead transmit a code event that has  
 to be referenced to CDMA network time. The code event does not represent a  
 time of day, but is instead an indication of time within a window of a few  
 minutes as opposed to twenty-four hours.

8 65. Therefore, CDMA handsets lack the same or equivalent structure, and do  
 9 not perform the identical function recited in this element. The same is true of  
 the accused MSMs which are a component of the handsets.

10 (Ex. 23 at 5-6.) After trial, in granting Qualcomm’s motion for judgment as a matter of law of  
 11 noninfringement of claim 11 of the ’390 patent, the Court found that:

12 There was no evidence that Samsung cellular telephones which contained  
 13 chipsets manufactured by defendant Qualcomm and used in a cellular telephone  
 14 system of defendant Snaptrack performed the identical or equivalent function of  
 15 the means-plus-function claim element “timing circuits for providing precise  
 16 time-of-day information” as those terms were defined by the Court.... Although  
 the Court makes its finding independent of the jury’s determination, it notes  
 that the jury found no infringement by the defendants of either the ’770 or the  
 ’130 patents’ claims which contain...timing circuit elements which are identical  
 to those claimed in the ’390 patent. (Ex. 25 at 4-5.)

17 With respect to claim 11 of the ’390 patent and claims 14, 17-18 and 21-22 of the ’889  
 18 patent in this case, Zoltar makes the same argument and the same infringement contentions  
 19 regarding “precise time-of-day” that it made in *Zoltar I*. (*Compare* Ex. 17 at 6 with Ex. 15 at 7.)  
 20 *See Hill*, 2005 WL 2488715, at \*3. As with the “location” claim limitation, the MS-assisted mode  
 21 of operation of the gpsOne chipset technology at issue in the two cases is the same for purposes of  
 22 the “precise time-of-day” limitation of the asserted claims, even though the chipset numbers have  
 23 changed. (Patrick Decl., ¶ 6.) As the same claim element is at issue and asserted against products  
 24 using the same gpsOne technology in both *Zoltar I* and *Zoltar II*, there is no genuine issue of  
 25 material fact as to whether issues raised regarding the term “precise time-of-day information” are  
 26 identical.

### 3. Issues Relating to the “Demodulator” Limitation Are Identical

The issue of whether the MS-assisted mode of operation of accused cellular telephone handsets containing gpsOne chipset technology contains a “demodulator” is also the same in both actions. In *Zoltar I*, the Court construed “demodulator” in the phrase “demodulator for demodulating the received navigational information” to mean “a circuit within the navigational receiver which extracts positional aiding information from an electronic signal or carrier.” (Ex. 19 at 4-5.) The Court applied this construction to find that the accused MS-assisted mode gpsOne chipsets do not demodulate navigational information from received GPS signals. (Ex. 25 at 4.) Granting Qualcomm’s motion for judgment as a matter of law of noninfringement of claim 11 of the ’390 patent, this Court found that:

There was no evidence that Samsung cellular telephones which contained chipsets manufactured by defendant Qualcomm and used in a cellular telephone system of defendant Snaptrack performed the identical or equivalent function of the means-plus-function claim element “a demodulator for demodulating the received navigational information” as those terms were defined by the Court. . . . Although the Court makes its finding independent of the jury’s determination, it notes that the jury found no infringement by the defendants of either the ’770 or the ’130 patents’ claims which contain demodulator elements which are identical to those claimed in the ’390 patent.

(*Id.* at 4-5.) The Court relied again on Dr. Wicker’s testimony in granting Qualcomm’s motion for summary adjudication of noninfringement, ruling that “[s]tandard ‘stand alone’ GPS receivers obtain the [satellites’] locations by demodulating the L1 signals and extracting the ephemeris data . . . the accused products do not do this, but instead depend on other elements of the system in which they are used to demodulate the L1 signals, extract the ephemeris information and perform the location computation.” (Ex. 22 at 3.)

In this second suit, *Zoltar* simply parrots the same infringement contentions for “demodulator” that it offered in *Zoltar I*. (*Compare* Ex. 17 at 6 with Ex. 15 at 11.) *See Hill*, 2005 WL 2488715, at \*3. Once again, the MS-assisted mode of operation of cellular phone handsets containing gpsOne chipset technology is the same in both cases for purposes of the “demodulator” limitation of asserted claim 11 of the ’390 patent and claims 14, 17-18 and 21-22 of the ’889 patent, even though the chipset numbers have changed. (Patrick Decl., ¶ 7.) There is complete identity of

1 issues as to infringement of claims containing the “demodulator” limitation.

2 **4. All Three Issues Remain Identical As Applied to the ’889 Patent and the**  
 3 **Newly Accused Products In *Zoltar II***

4 While Zoltar alleges infringement of one patent (the ’889 patent) and a number of cellular  
 5 handsets containing Qualcomm chipsets not at issue during *Zoltar I*, the issues described above are  
 6 exactly the same as applied to this new patent and these chipsets. The asserted claims of the ’889  
 7 patent contain the same three limitations described above, and the additional gpsOne chipsets  
 8 accused by Zoltar operate in exactly the same way as the chipsets at issue in *Zoltar I*. Collateral  
 9 estoppel thus applies equally to Zoltar’s claims under the ’889 patent and against the MS-assisted  
 10 mode of operation of the accused LGE MobileComm cellular handsets containing these additional  
 11 gpsOne chipsets.

12 **a. Issues Related to the ’889 Patent Are Identical To Those Litigated**  
 13 **in *Zoltar I* For Purposes of Collateral Estoppel**

14 As discussed in Section II(A), *supra*, for purposes of this Motion, the ’889 patent is exactly  
 15 the same in all relevant respects as the patents at issue in *Zoltar I*. The terms construed in *Zoltar I*  
 16 appear repeatedly throughout the claims of the ’889 patent, including the terms “navigational  
 17 receiver for providing a location of the remote unit,” “timing circuits for providing precise time-of-  
 18 day information,” and a “demodulator for demodulating received navigational information.” (Ex. 4  
 19 at 29:41-43, 30:50-54, 31:15-21, 32:4-10.) Such similarities are wholly intentional, as the ’889  
 20 patent is a continuation-in-part of the ’390 patent and is part of the same patent family as all three  
 21 patents-in-suit in *Zoltar I*. Collateral estoppel also bars infringement claims under a different patent  
 22 not asserted in the first action where the patents are identical in all respects relevant to issues of  
 23 infringement. *See, e.g., Vigil v. Walt Disney Co.*, 2003 WL 22016805, at \*4 (N.D. Cal. July 31,  
 24 2003).

25 The Federal Circuit applied this principle in *Amgen*. Patentee Genetics sued Amgen and  
 26 other defendants in a first case alleging infringement of a “parent” patent relating to a drug  
 27 treatment for anemia. 98 F.3d at 1329. In the prior case, the court found the parent patent invalid  
 28 for lack of enablement and the Federal Circuit affirmed. *Id.* In a later case, Genetics asserted

1 infringement of a “child” patent sharing the same disclosure as its parent. The court granted  
 2 Amgen’s motion for summary judgment barring Genetics from asserting infringement of the child  
 3 patent and the Federal Circuit affirmed, ruling that Genetics’ infringement allegations resulted in  
 4 claim scope implicating the previously litigated enablement issue. *Id.* at 1332. The court rejected  
 5 Genetics’ argument that the child patent had not been interpreted or even issued prior to judgment  
 6 in the previous case, holding that the enablement issue was “fully litigated for the identical product  
 7 on the identical specification” and “[t]hat issue can not be relitigated, although it could not be raised  
 8 until the continuation patent was granted.” *Id.*

9 **b. Issues In Both Suits Related to the MS-Assisted Mode of**  
 10 **Operation of Cellular Handsets Using gpsOne Chipset**  
**Technology Are Identical for Purposes of Collateral Estoppel**

11 Similarly, while Zoltar now accuses LGE MobileComm cellular telephone handsets  
 12 including several Qualcomm chipsets not at issue in *Zoltar I*, those handsets use the same gpsOne  
 13 chipset technology in the MS-assisted mode of operation and operate in exactly the same way as the  
 14 MSM 3300 and MSM 5100 chipsets for purposes of determining pseudoranges. (Patrick Decl., ¶  
 15 5.) None of them calculate the user’s location. (*Id.*) Like cellular phone handsets using the MSM  
 16 3300 and MSM 5100, the MS-assisted mode of operation of the accused LGE MobileComm  
 17 handsets using gpsOne chipset technology does not provide precise time-of-day, and does not  
 18 demodulate received navigational information. (*Id.*, ¶¶ 6-7.) Infringement claims may be estopped  
 19 as to different products than those at issue in a prior suit if “premised on identical claim language  
 20 that formed the basis for the previously rejected infringement claim” and if the products operate in  
 21 the same way for purposes of infringement. *Id.* at 1125; *see also Home Diagnostics Inc. v.*  
 22 *LifeScan, Inc.*, 120 F. Supp. 2d 864, 870 (N.D. Cal. 2000); *Security People*, 59 F. Supp. 2d at 1045;  
 23 *Overhead Door Corp. v. Whiting Roll-Up Door Mfg. Co.*, 215 U.S.P.Q. 428, 433 (W.D.N.Y. 1981)  
 24 (“In order for a defendant to successfully assert collateral estoppel against a patentee, however, it is  
 25 not necessary for the second accused device to be the exact same device as was previously found  
 26 non-infringing.”).

1 In *Molinaro v. Fannon/Courier Corp.*, for instance, the Federal Circuit affirmed that  
2 collateral estoppel precluded infringement allegations in a second case based on a finding of non-  
3 infringement in a first case involving the products of a different defendant. 745 F.2d at 653-54.  
4 Plaintiff in *Molinaro* filed numerous lawsuits against more than fifteen defendants, accusing their  
5 radio receiver products of infringement. *Id.* at 653. After resolution of one of those cases,  
6 defendant Fannon/Courier moved for summary judgment in a separate case, asserting that collateral  
7 estoppel barred plaintiff's infringement allegations as to its radio receivers. *Id.* The Federal Circuit  
8 affirmed an order granting that motion, ruling that "where a determination of the scope of patent  
9 claims was made in a prior case, and the determination was essential to the judgment there on the  
10 issue of infringement, there is collateral estoppel in a later case on the scope of such claims, i.e., the  
11 determined scope cannot be changed." *Id.* at 655. The Court found that "the identical issue was  
12 decided previously; that issue was fully litigated in a previous case; the resolution of that issue was  
13 essential to a final judgment there; and the patent owner had a full and fair opportunity to litigate  
14 that issue." *Id.* Here, as in *Molinaro*, Zoltar had a full and fair opportunity to litigate issues relating  
15 to the "location," "precise time-of-day" and "demodulator" claim limitations as applied to the MS-  
16 assisted mode of operation of cellular telephone handsets using gpsOne chipset technology, and  
17 should be estopped from litigating them again.

18 This Court applied the holding of *Molinaro* in *Home Diagnostics* to preclude infringement  
19 claims against a defendant's new products based on a prior judgment of non-infringement of its  
20 older products, where, as here, the "operational features" relevant to the claims were the same in  
21 both products. 120 F. Supp. 2d at 867. The court held that "[i]f a structure in a product is found to  
22 be identical to a structure in an otherwise different, previously litigated product, the judgment as to  
23 whether that structure meets the relevant claim element must apply to the later litigation to avoid  
24 repetitive litigation of the same issues." *Id.* at 868. Just as in *Home Diagnostics*, Zoltar's  
25 infringement contentions regarding "location," "precise time-of-day" and "demodulator" elements,  
26 both here and in *Zoltar I*, relate to the same operational features of the MS-assisted mode of  
27 operation of the accused LGE MobileComm handsets using gpsOne chipset technology. Because  
28



1 the same claim elements are at issue and asserted against products using the same technology, there  
 2 is no genuine issue of material fact as to whether issues raised regarding the terms “location,”  
 3 “demodulator” and “precise time-of-day” are identical in the two cases as applied to the ’889 patent  
 4 and the MS-assisted mode of operation of the accused LGE MobileComm cellular handsets using  
 5 gpsOne chipset technology.

6 **B. The Issue of Whether the MS-Assisted Mode of Operation of Handsets Using**  
 7 **gpsOne Chipset Technology Meets These Claim Limitations Was Actually**  
 8 **Litigated in *Zoltar I***

9 There also can be no dispute as to the second element of LGE MobileComm’s collateral  
 10 estoppel defense – that the issue of whether the MS-assisted mode of operation of cellular phone  
 11 handsets using gpsOne chipset technology meets the “location,” “precise time-of-day” and  
 12 “demodulator” claim limitations of the Zoltar Patents was actually litigated in *Zoltar I*. The parties  
 13 filed lengthy claim construction briefs to support their proposed constructions of these three claim  
 14 terms, and argued their positions in two separate *Markman* hearings. The Court issued three  
 15 separate orders construing these terms, and even held a third round of briefing to refine its  
 16 construction of the term “location.” The parties submitted multiple summary judgment motions  
 17 requiring the Court to apply its constructions of these three terms, and fully briefed and argued  
 18 those motions before this Court issued full and considered rulings on each, in some cases  
 19 entertaining motions for reconsideration. Zoltar also had the opportunity to present its case to a jury  
 20 in a three-week trial, and to fully brief and argue post-trial motions for judgment as a matter of law.  
 21 There is no serious question that infringement issues raised in this case regarding the terms  
 22 “location,” “precise time-of-day” and “demodulator” were fully litigated in *Zoltar I*. *See In re*  
 23 *Freeman*, 30 F.3d at 1466.

24 **C. The Court’s Findings in *Zoltar I* as to Whether the MS-Assisted Mode of**  
 25 **Operation of Cellular Handsets Using gpsOne Chipset Technology Meet the**  
 26 **“Location,” “Precise Time-of Day” and “Demodulator” Limitations of the**  
 27 **Zoltar Patents Were Necessary to Support Final Judgments**

28 Likewise, there is no material dispute that the Court’s findings in *Zoltar I* regarding whether  
 the MS-assisted mode of operation of cellular phone handsets using gpsOne chipset technology

1 meets the “location,” “precise time-of-day” and “demodulator” claim limitations of the Zoltar  
 2 Patents were necessary to support final judgments. As detailed above, the Court issued final  
 3 judgments in *Zoltar I* for purposes of collateral estoppel in ruling on the parties’ summary judgment  
 4 motions, applying its construction of these claim terms to the accused technology. *See id.* at 1466-  
 5 67. The Court’s construction of these three terms was provided to the jury for use in its  
 6 infringement determination, and the jury’s noninfringement verdict in *Zoltar I* directly resulted from  
 7 those constructions and the evidence presented at trial. In each case, the Court’s construction of  
 8 these claim elements and its (and the jury’s) findings that these limitations were absent in the  
 9 accused products were necessary to support a final judgment for purposes of collateral estoppel —  
 10 particularly the summary judgment and judgment as a matter of law orders described above. As to  
 11 the third element of LGE MobileComm’s collateral estoppel defense, there is once again no genuine  
 12 issue of material fact.

13 **D. Zoltar Had a Full and Fair Opportunity in *Zoltar I* to Litigate Whether the MS-**  
 14 **Assisted Mode of Operation of Cellular Handsets Using gpsOne Chipset**  
 15 **Technology Meets the “Location,” “Precise Time-of-Day” and “Demodulator”**  
 16 **Claim Limitations of the Zoltar Patents**

17 Finally, there is no material dispute that Zoltar had a full and fair opportunity in *Zoltar I* to  
 18 litigate whether the MS-assisted mode of operation of cellular telephone handsets using gpsOne  
 19 chipset technology meet the “location,” “precise time-of-day” and “demodulator” claim limitations  
 20 of the Zoltar Patents. Zoltar, the assignee of those patents, took the opportunity to propose  
 21 constructions of these three terms in *Zoltar I*, and had every opportunity to prove – whether on  
 22 summary judgment, at trial, or during post-trial motions – that the MS-assisted mode of operation of  
 23 the cellular telephone handsets containing gpsOne chipset technology it accused in *Zoltar I* and  
 24 accuses again in *Zoltar II* infringe the claims of the Zoltar Patents. Zoltar was given the benefit of  
 25 an entire trial through jury verdict, and fully participated in post-trial motions. Zoltar clearly had a  
 26 full and fair opportunity in *Zoltar I* to litigate the issue of whether the MS-assisted mode of  
 27 operation of cellular telephone handsets using gpsOne chipset technology meets the “location,”  
 28 “precise time-of-day” and “demodulator” claim limitations of the patents-in-suit, and thus no

1 genuine issue of material fact exists as to the final element of LGE MobileComm's collateral  
2 estoppel defense. *See Pharmacia*, 170 F.3d at 1380.

3 **V. CONCLUSION**

4 For the foregoing reasons, LGE MobileComm respectfully requests that the Court grant its  
5 motion for summary judgment of collateral estoppel to bar relitigation of infringement of the  
6 "location," "precise time-of-day" and "demodulator" claim limitations as they relate to the MS-  
7 assisted mode of operation of LGE MobileComm cellular telephone handsets using gpsOne chipset  
8 technology.

9 Dated: April 23, 2007

FISH & RICHARDSON P.C.

11 By: /s/ Shelley K. Mack  
12 Shelley K Mack

13 Attorneys for Defendant  
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